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 17 Inc., Cisco-Linksys, LLC, D-Link Systems, Inc.
 18 and NETGEAR, Inc.

19 [Additional Counsel Listed On Signature Page]

20 UNITED STATES DISTRICT COURT

21 NORTHERN DISTRICT OF CALIFORNIA, OAKLAND DIVISION

22 OPTIMUMPATH, L.L.C.,

23 CASE NO. 4:09-CV-1398-CW

24 Plaintiff,

25 **DEFENDANTS' REPLY IN SUPPORT OF**
MOTION TO PRECLUDE PLAINTIFF
FROM ASSERTING A THEORY OF
INFRINGEMENT UNDER THE
DOCTRINE OF EQUIVALENTS AND TO
STRIKE PORTIONS OF DR.
DAHLBERG'S EXPERT REPORT
DISCUSSING THE DOCTRINE OF
EQUIVALENTS

26 vs.

27 BELKIN INTERNATIONAL, INC., CISCO-
 28 LINKSYS, LLC, D-LINK SYSTEMS, INC.
 29 NETGEAR, INC. AND SMC NETWORKS,
 30 INC.,

31 Defendants.

32 Date: December 9, 2010
 33 Time: 2:00 pm

34 The Honorable Claudia Wilken

1 **I. INTRODUCTION**

2 OptimumPath admits that “it did not specifically plead the Doctrine of Equivalents” and
 3 never “expressly indicated that it expect[ed] to proceed with a Doctrine of Equivalents argument.”
 4 (Doc. No. 228 at 2, 8.) It does not deny that the claim charts included with its infringement
 5 contentions allege only literal infringement. And it makes no effort to distinguish the case law
 6 cited by Defendants, which holds that a patentee may not ambush defendants with a new theory of
 7 infringement at the expert report stage—as OptimumPath has done here.

8 Realizing that it has no chance of succeeding on the merits, OptimumPath resorts to
 9 obfuscation and slight-of-hand. It throws an amalgamation of misleading and contradictory
 10 arguments at the Court, hoping that something will stick. In essence, OptimumPath argues that
 11 Defendants should have realized OptimumPath was alleging the doctrine of equivalents based on a
 12 small number of disjointed clues scattered throughout the discovery process.

13 The Patent Local Rules were designed to prevent exactly this kind of litigation conduct. It
 14 is not Defendants’ job to guess whether OptimumPath is asserting infringement under the doctrine
 15 of equivalents. Rule 3-1(e) explicitly requires the patentee to provide that information upfront at
 16 the beginning of the case. OptimumPath did not do so. Furthermore, OptimumPath does not even
 17 attempt to show that it diligently pursued a doctrine of equivalents theory and that good cause
 18 exists for adding its doctrine of equivalents theory for the first time in its expert report on
 19 infringement. As a consequence, OptimumPath should be precluded from asserting the doctrine of
 20 equivalents and the portions of its expert report relating to the doctrine of equivalents should be
 21 stricken.

22 **II. OPTIMUMPATH’S PATENT LOCAL RULE 3-1 DISCLOSURES DID NOT PUT**
 23 **DEFENDANTS ON NOTICE OF ITS DOCTRINE OF EQUIVALENTS THEORY**

24 OptimumPath argues that its infringement contentions disclosed its doctrine of equivalents
 25 theory because the contentions include the phrase “substantially similar.” However, OptimumPath
 26 fails to inform the Court that the passage that includes the “substantially similar” phrase has
 27 absolutely nothing to do with the doctrine of equivalents.

1 OptimumPath does not dispute that its Patent Local Rule 3-1(e) disclosure, which requires
2 the patentee to state in its infringement contentions “[w]hether each limitation of each asserted
3 claim is alleged to be literally present or present under the doctrine of equivalents in the Accused
4 Instrumentality,” fails to allege infringement of any of the asserted claims or limitations of those
5 claims under the doctrine of equivalents. Instead, OptimumPath claims that the presence of the
6 phrase “substantially similar” in its Patent Local Rule 3-1(c) disclosure (reproduced below)
7 somehow put Defendants on notice of its doctrine of equivalents theory.¹

Patent L.R. 3-1(c)

9 OptimumPath's disclosures pursuant to Patent L.R. 3-1 (c) are set forth in the chart attached
10 hereto as Exhibit A. For purposes of infringement of the '281 Patent and the disclosure requirements of
11 L.R. 3-1(c), OptimumPath asserts that the Accused Instrumentalities all function in the same or
12 substantially similar manner and include the same or substantially similar components. For this reason,
13 OptimumPath provides a claim chart for only a single, exemplary Accused Instrumentality and alleges
14 that the remainder of the Accused Instrumentalities infringe in the same manner.

16 As OptimumPath knows, the use of the phrase “substantially similar” in this paragraph has
17 no relationship whatsoever with the doctrine of equivalents. Rather, this paragraph states that “the
18 Accused Instrumentalities all function in the same or substantially similar manner and include the
19 same or substantially similar components.” In other words, OptimumPath is explaining that it
20 only provided a single claim chart under Patent Local Rule 3-1(c) because the numerous accused
21 products are “substantially similar” to one another.

22 OptimumPath nowhere states that there are insubstantial differences between the features
23 of Defendants' accused products and corresponding limitations of the asserted claims, or that
24 features of Defendants' accused products perform substantially the same function, in substantially
25 the same way, producing substantially the same result as corresponding limitations of the asserted

²⁷ ¹ Patent Local Rule 3-1(c) requires a patentee to prepare “a chart identifying specifically where each limitation of each asserted claim is found within each Accused Instrumentality. . . .”

1 claims, as required by the doctrine of equivalents. See TIP Systems, LLC v. Phillips &
 2 Brooks/Gladwin, Inc., 529 F.3d 1364, 1376 (Fed. Cir. 2008) (“Whether equivalency exists may
 3 be determined based on the ‘insubstantial differences’ test or based on the ‘triple identity’ test,
 4 namely, whether the element of the accused device ‘performs substantially the same function in
 5 substantially the same way to obtain the same result.’ (citations omitted)). OptimumPath’s
 6 argument that its Patent Local Rule 3-1(c) disclosure provides notice of its doctrine of equivalents
 7 theory is disingenuous and should be set aside.

8 **III. DEFENDANTS DID NOT TAKE DISCOVERY ON THE DOCTRINE OF**
 9 **EQUIVALENTS**

10 OptimumPath argues that Defendants conducted discovery on the doctrine of equivalents.
 11 (Doc. No. 228 at 5.) In support of this argument, OptimumPath cites to the depositions of Andrew
 12 Tompkins, the co-inventor of the patent-in-suit, and Glenn Wheeler, the 30(b)(6) witness for
 13 TAEUS. During those depositions, however, Defendants were eliciting testimony to support their
 14 claim constructions and their positions as to why the accused products do not *literally* infringe the
 15 patent-in-suit; they were not eliciting testimony on the doctrine of equivalents.

16 Defendants contend that the “network card” and “wireless card” claimed in the ‘281 Patent
 17 are printed circuit boards separate from one another that can be inserted into and removed from
 18 electrical connectors in the chassis of the wireless provisioning device. In the excerpts cited by
 19 OptimumPath, Defendants sought, and obtained, deposition testimony supporting those
 20 constructions. Indeed, in the excerpt of Mr. Wheeler’s deposition, Defendants’ counsel made
 21 clear that he was *not* asking whether elements of Defendants’ products were equivalent to the
 22 network cards and wireless cards claimed in the ‘281 Patent, but whether the so-called wireless
 23 cards and network cards identified by TAEUS were separate from the main printed circuit board.
 24 (Doc. No. 229-3 at 94:6-8 (“Mr. Briggs: But that didn’t answer my question. My question was,
 25 there [is] not a separate network card and separate wireless card in here, correct?”).)

26 OptimumPath does not—and cannot—identify any questions from Defendants regarding
 27 insubstantial differences between claim limitations and corresponding features in Defendants’
 28 accused products or questions regarding claim limitations and corresponding features in

1 Defendants' accused products that perform substantially the same function, in substantially the
 2 same way, to obtain substantially the same result. Aside from excerpts from two depositions,
 3 OptimumPath has not identified *any* other discovery taken by Defendants relating to the doctrine
 4 of equivalents. After all, Defendants had no reason to take discovery on the doctrine of
 5 equivalents.

6 OptimumPath also cites excerpts from its depositions of Defendants. Even assuming the
 7 questions asked by OptimumPath relate to the doctrine of equivalents, three of the four depositions
 8 cited by OptimumPath took place after the close of fact discovery and confirm that
 9 OptimumPath's doctrine of equivalents allegation is untimely.² Furthermore, that OptimumPath
 10 asked questions that arguably relate to the doctrine of equivalents is not sufficient to give
 11 Defendants notice of OptimumPath's reliance on that theory. Defendants are not required to read
 12 the tea leaves of the patentee's deposition questions to determine whether the patentee is relying
 13 on the doctrine of equivalents. Rather, the Patent Local Rules explicitly require the patentee to
 14 disclose that information in its infringement contentions. Patent L.R. 3-1(e).

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² Although OptimumPath filed this case in January 2008, it did not issue a single deposition notice until Friday, July 30, 2010 – more than 2.5 years after the filing of its lawsuit and just 25 business days before the close of fact discovery. On that day, OptimumPath served 30(b)(6) notices on each of the five remaining defendants seeking testimony on nearly every conceivable issue in this complex patent infringement case and scheduling the depositions within a narrow window during the last two weeks of discovery. Given the breadth of the 30(b)(6) topics, the number of defendants in this case, and late summer timing, OptimumPath could not have reasonably expected to complete these 30(b)(6) depositions by the close of discovery. Four of the five Defendants were not able to schedule the depositions prior to the cutoff date. As a courtesy to OptimumPath and in the interest of avoiding Court intervention, Defendants agreed to allow OptimumPath to take those depositions after the close of fact discovery. The only deposition that took place before the discovery cutoff date was the SMC 30(b)(6) deposition, which took place on August 31, 2010, four days before discovery closed.

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1 **IV. OPTIMUMPATH CANNOT USE THE LACK OF A CLAIM CONSTRUCTION**
 2 **RULING AS AN EXCUSE FOR ITS FAILURE TO ALLEGE THE DOCTRINE OF**
 3 **EQUIVALENTS**

4 In its final argument, OptimumPath completely changes gears and argues that it did not
 5 disclose its doctrine of equivalents theory in its infringement contentions because it could not
 6 anticipate the need to rely on the doctrine absent a claim construction ruling. (Doc. No. 228 at 8.)

7 First, this argument contradicts OptimumPath's earlier arguments that it actually did
 8 disclose the doctrine of equivalents in its infringement contentions and took discovery on the issue
 9 during its depositions of Defendants.

10 Second, OptimumPath does not explain how, if a claim construction is necessary before
 11 alleging infringement under the doctrine of equivalents, it nonetheless managed to include a
 12 doctrine of equivalents theory in its expert report.

13 [REDACTED]

14 [REDACTED]

15 [REDACTED]

16 [REDACTED]

17 Fourth, OptimumPath does not deny that it has known of Defendants' proposed claim
 18 constructions—which, if adopted, would defeat OptimumPath's literal infringement claims—since
 19 December 2009.

20 Fifth, OptimumPath's argument that it could not anticipate the need to allege the doctrine
 21 of equivalents until after a claim construction ruling frustrates the intent of the Patent Local Rules
 22 and confuses the purpose of infringement contentions and claim construction. The Patent Local
 23 Rules require the parties to "put all their cards on the table up front," Amtel Corp. v. Information
24 Storage Devices, Inc., 1998 WL 775115, at *2 (N.D. Cal. Nov. 5, 1998), and "crystallize their

25 theories of the case early in the litigation and to adhere to those theories once they have been
 26 disclosed." MEMC Elec. Materials v. Mitsubishi Materials Silicon Corp., 2004 WL 5363616, at
 27 *4 (N.D. Cal. Mar. 2, 2004) (internal quotations omitted). Claim construction, on the other hand,

1 is designed to determine the proper reading of the patent claims, as a matter of law, and to clarify
 2 disputed issues of the case. Claim construction is not designed to provide plaintiffs with an
 3 opportunity to set forth new infringement theories, as OptimumPath suggests.

4 Though OptimumPath argues that its proposed claim constructions should be adopted, its
 5 confidence in its case does not release it from its obligation “to lay all its cards on the table” at the
 6 forefront. [REDACTED]

7 [REDACTED] Moreover, OptimumPath has had over
 8 a year to analyze Defendants’ proposed claim constructions and determine whether the doctrine of
 9 equivalents may be necessary. If OptimumPath wished to claim infringement under the doctrine
 10 of equivalents in the event of an adverse claim construction ruling, it should have diligently sought
 11 amendment of its infringement contentions soon after it was notified of Defendants’ proposed
 12 claim constructions. It did not. OptimumPath failed to diligently pursue its doctrine of
 13 equivalents infringement theory and has not otherwise demonstrated good cause for pursuing its
 14 new infringement theory as required by Patent Local Rule 3-6. See O2 Micro Int’l Ltd. v.
 15 Monolithic Power Sys., Inc., 467 F.3d 1355, 1366 (Fed. Cir. 2006) (affirming the Northern
 16 District of California’s finding that “good cause” requires a showing of diligence under the Patent
 17 Local Rules); see also Johnson v. Mammoth Recreations, 975 F.2d 604, 609 (9th Cir. 1992) (“If
 18 [a] party was not diligent, the [good cause] inquiry should end.”). Consequently, OptimumPath
 19 should not now be permitted to pursue its doctrine of equivalents allegations.

20 **IV. CONCLUSION**

21 For the foregoing reasons, OptimumPath should be precluded from asserting infringement
 22 under the doctrine of equivalents, and all portions of its expert reports which discuss the doctrine
 23 should be stricken.

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1 DATED: November 23, 2010

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4 QUINN EMANUEL URQUHART &
5 SULLIVAN, LLP

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10 DATED: November 23, 2010

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